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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,151

Applicant(s)

FRAKI ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, drawn to a method for administering digital collectible cards in communication network, and a digital collectible card system in a communication network, classified in class 705, subclass 26.
- II. Claims 27 and 28, drawn to a digital collectable card stored in an electronic memory, classified in class 463, subclass 29.
- III. Claim 29, drawn to a computer program product, classified in class 455, subclass 415.
- IV. Claim 30, drawn to a mobile terminal, classified in class 455, subclass 566.
- V. Claim 31, drawn to a method for owning a digital collectible card, classified in class 463, subclass 42.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I is directed towards a system used for administering digital

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collectible cards while invention II is directed towards the card stored in an electronic memory which is unrelated to the system.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I is directed towards a system and invention III is directed towards a computer program product.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the mobile terminal lacks an input user interface, memory, an output user interface, a transceiver, and a processor. The subcombination has separate utility such as communicating between two parties.

Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I is directed toward a method for administering digital

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collectible cards in a communication network while invention V is directed towards a method for owning a digital collectible card.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention II is directed towards a digital collectible card and invention III is directed towards a computer program product.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention II is directed towards a digital collectible card and invention IV is directed towards a mobile terminal.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention II is directed towards a digital card, a product, and invention V is directed towards a method for owning a digital card to be displayed on a wireless user terminal.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention III is directed towards a computer program product and invention IV is directed towards a mobile terminal.

Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention III is directed towards a computer program product to be run on a system and invention V is directed towards a method for owning a digital collectible card for being displayed on a wireless user terminal.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention IV is a mobile terminal for viewing digital collectible cards and inventions V is directed towards a process for owning a digital collectible card to be displayed on a wired user terminal.

Furthermore, this application contains claims directed to the following patentably distinct species of the digital collectible card:

- IA. No Figure shown; a card having streamed video,
- IB. No Figure shown; a card having an advertisement;
- IC. No Figure shown; a card having digital music;
- ID. Figure 6; a card having a video clip; and,
- IE. No Figure shown; a card having an avatar feature.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Joseph Gamberdell on August 21, 2003 a provisional election was made with traverse to prosecute the invention of group I and species IC, claims 1-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the server communicating with the mobile terminal (claim 22) must be shown in Fig. 9 or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1, 2, 8, 11, 16, 20 and 22 are objected to because of the following informalities:

regarding claim 1, the first occurrence of "the" in line 3 should be --a--, the second occurrence of "the" in line 6 should be --an--;

regarding claim 2, the limitation "associated" in line 2 should be deleted;

regarding claim 8, it is unclear whether the "mobile terminals" in line 2 are different terminals than that recited in claim 1 in line 3, the first occurrence of "the" in line 4 should be --a--, and the limitation "on" in line 2 should be --of--;

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regarding claim 11, the limitation --the-- should be included before "user" in line 8;

regarding claim 16, the limitation "the" before "contents" in line 4 should be deleted;

regarding claim 20, the limitation "the" before "owners in lines 2 should be deleted; and,

regarding claim 22, it is unclear whether the digital physical card is communicating wirelessly with the terminal at the same time the server communicates with the terminal as required by claim 21. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Aberson, 6,546,400.

Regarding claim 21, Aberson discloses in Figure 11 a digital collectible card system, in a communication network 1106, comprising at least one mobile terminal 1104A and a server 1102 communicating with the mobile terminal 1104A via the communication network 1106.

Regarding claim 22, the system further includes a digital physical card 129 (Fig. 1). Applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 9-12, 14-18, 20, 21, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyberaction, Inc. (Filler et al.), WO00/11827, in view of Aberson, 6,546,400.

Regarding claim 1, Filler et al. disclose a method comprising:

identify a user of a terminal (the computer; page 9 line 29) in a communication network (normally a terminal is identified via an ethernet address in a service provider), the user enters the communication network using the terminal (users are known to enter the internet through a terminal); and

associate a digital collectible card with the user based on an identification received from the terminal (page 2, lines 17-20; page 15, lines 28-32). However, the terminal is not a mobile terminal. Aberson discloses a terminal being a mobile terminal (a laptop or hand-held device) to enter a communication network to use the internet (col. 12, lines 6-10). Therefore, as taught by Aberson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a mobile terminal to enter a communication network and use the internet.

Regarding claim 2, the user trades the card with a second user (page 27, lines 12-15). The second user becomes associated with the card after the trade (pg. 27, lines 35-36).

Regarding claim 3, trading the card is performed under control of a server (pg. 27, line 15-34).

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Regarding claim 5, the method further includes storing the card on a server and the associating of the card with the user is made at the server (pg 15, line 28 - pg. 16, line 5).

Regarding claim 6, the association indicates ownership of the card by the user.

Regarding claim 7, the method further includes notify the user of a given digital collectible card associated with a second user. The given collectible card is available for purchase or trade (pg. 27, line 20-22).

Regarding claim 9, the method further includes requesting to purchase the card before the associating the car with the user (pg. 13, lines 30-31).

Regarding claim 10, identifying the user in the communication network comprises entering a password at the mobile terminal (pg. 15, line 31-33).

Regarding claim 11, the method further includes transmit a request from the mobile terminal to a server to send the card to the mobile terminal; identify the user sending the request; compare the identity of the user with the user identification information associated with the card; and, provide the card to the user in response to matching the identity and the user identification information (pg. 15, lines 28 - pg. 16, line 5).

Regarding claim 12, provide the card to the user comprises transmit the card from the server to the mobile terminal via the communication network; and display the card on the terminal.

Regarding claim 14, the card includes at least one of a streamed video, an advertisement, digital music, a video clip (pg. 6, lines 9-15) and an avatar feature.

Regarding claim 15, the card includes at least one dynamic user-specific feature (pg. 2, lines 4-6).

Regarding claim 16, the card comprises data information (pg. 6, line 11), and the method further comprises updating data information of the card in real time based on a real event corresponding to contents of the card (col. 2, lines 6-11).

Regarding claim 17, updating data information of the card is done on request of the user (pg. 25, 2-8). Applicant is reminded that the information is accessible by a link upon being clicked by a user.

Regarding claim 18, the method further comprises adding an indicator, including a certain price for the card) to the card (pg. 2, line 12-14).

Regarding claim 20, the server stores digital collectible cards and association information identifying owners of the cards (pg. 9, line 3-4).

Regarding claims 21, 25 and 26, given the method of Filler et al., as modified by Aberson, a digital collectible card system is an inherent system, as those features recited in the claims are required to perform the method.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyberaction, Inc. (Filler et al.), WO00/11827, in view of Aberson, 6,546,400, as applied to claim 2 above, and further in view of Beuk et al., 5,774,673.

Regarding claim 4, Filler et al., as modified by Aberson, teaches trading the card with the second user includes storing the digital card at a first mobile terminal and transferring the card from the first mobile terminal to a second mobile terminal. However, the trading is not transferred via a wireless communication. Beuk et al. teach in Figure 1 trading data between a first terminal and a second terminal via a wireless communication (infrared communication) to communicate and share files wirelessly. Therefore, as taught by Beuk et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to transfer the digital cards between two mobile terminals via a wireless communication to trade the cards.

Regarding claims 23, given the method of Filler et al., as modified by Aberson and Beuk et al., a digital collectible card system is an inherent system, as those features recited in the claims are required to perform the method.

Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cyberaction, Inc. (Filler et al.), WO00/11827, in view of Aberson, 6,546,400, as applied to claims 1 above, and further in view of Treyz et al., 6,587,835.

Regarding claim 8, Kato et al., as modified by Peppel, disclose keeping location information of mobile terminals in the communication network. Applicant is reminded that communication networks store account information, especially an address, password, or both of a user. However, Kato et al., as modified above, fails to determine vicinity of a second user based on the location information of the mobile terminal of the user and of the mobile terminal of the second user. Treyz et al. teach determining vicinity of a second user based on the location information of the mobile terminal of the user and of the mobile terminal of a second user to find proximity of the second user with respect to the user (col. 45, lines 21-30). Therefore, as taught by Treyz et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine vicinity of a second user based on the location information of the mobile terminal of the user and of the mobile terminal of the second user to find proximity of the second user with respect to the user.

Regarding claims 24, given the method of Filler et al., as modified by Aberson and Treyz et al., a digital collectible card system is an inherent system, as those features recited in the claims are required to perform the method of claim 24.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyberaction, Inc. (Filler et al.), WO00/11827, in view of Aberson, 6,546,400, as applied to claim 11 above, and further in view of Peppel, 6,200,216.

Regarding claim 13, Filler et al., as discussed above, fails to disclose providing the user with the digital collectible card comprises providing the card for view on the mobile terminal for a limited period of time only. Peppel teaches on column 6, in lines 29-37 providing the card for view on the mobile terminal for a limited period of time only to generate scarcity in cards.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cyberaction, Inc. (Filler et al.), WO00/11827, in view of Aberson, 6,546,400, as applied to claim 1 above, and further in view of Martin, Jr. et al., 6,610,105.

Regarding claim 19, Filler et al., as modified by Aberson, does not disclose the communication network including a cellular mobile communication network. Filler et al. do not specify details of the communication network but suggest that any area communication network can be employed (pg. 10, line 8-10). Since Aberson suggests

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to use a mobile terminal to trade cards, Martin, Jr. et al. teach the use of a cellular mobile communication network to connect to the internet (col. 1, line 64 to col. 2, line 8). Therefore, as taught by Martin, Jr. et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the communication network of Filler et al. into a cellular mobile communication network to connect to the internet and trade the digital cards.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al., 6,336,142, in view of , Peppel, 6,200,216.

Regarding claim 1, Kato et al. disclose a method comprising:

identify a user of a mobile terminal in a communication network (normally a user is registered to use the network and identified by the network), the user enters the communication network using the mobile terminal (users are known to enter the network to obtain digital data). However, Kato discloses digital data associated with the user based on an identification received from the mobile terminal instead of a digital collectible card. Peppel teaches associating a digital collectible card with the user by sending the card via email or on-line to the user. Therefore, as taught by Aberson, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the digital data for a collectible digital card since a digital card is comprised of digital data that can be transferred to the mobile terminal via a communication network.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



**Lynne H. Browne
Supervisory Patent Examiner
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E.G.

August 28, 2003